

REMARKS

This is in full and timely response to the non-final Office Action dated September 28, 2006. The present Amendment amends claims 21, 23, and 24 and cancels claims 26-28 in order to further clarify a portion of the scope sought to be patented, and otherwise disputes certain findings of fact made in connection with the rejection of the claims. New claims 29 and 30, mirroring the language of previous claims 21, 24, 25, and 28, have also been added. Support for these amendments can be found variously throughout the specification, including, for example, page 18, line 18 through page 19, line 5. *No new matter has been added.*

Accordingly, claims 21-25, 29, and 30 are presently pending in the application, each of which is believed to be in immediate condition for allowance. Reexamination and reconsideration in light of the present Amendment and the following remarks are respectfully requested.

New Claims

Support for new claims 29 and 30 can be found variously throughout the specification and claims. In particular, independent claim 29 incorporates the allowable subject matter of claim 24, and includes the subject matter of previous claims 21 and 28 from which claim 24 previously depended in the alternative. Claim 30 depends from independent claim 29, and mirrors the language of claim 25.

Accordingly, since these new claims are clearly distinguishable from the applied art of record, allowance of the same is courteously solicited.

Claim to Priority

Acknowledgement of the proper receipt of the certified formal papers filed in connection with Applicant's claim to priority under 35 U.S.C. § 119(a)-(d) is noted with appreciation.

Information Disclosure Statement

It is also noted with appreciation that the Information Disclosure Statement filed on December 17, 2003 has been considered by the Examiner.

Claim Rejections- 35 U.S.C. § 112

In the Action, claims 23-26 were rejected under 35 U.S.C. § 112, second paragraph, for alleged indefiniteness. Applicant respectfully traverses this rejection. However, in order to expedite prosecution, claims 23-25 have been amended. With this Amendment, claim 26 has been canceled. Withdrawal of this rejection is therefore courteously solicited.

Claim Rejections- 35 U.S.C. § 103

In the Action, claims 21 and 28 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 4,438,004 to Myers (“Myers”). Claims 26, 27, and 28 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 4,505,987 to Yamada et al. (“Yamada”). This rejection is respectfully traversed.

Claims 26-28 are now canceled without prejudice or disclaimer, and without necessarily agreeing with or acquiescing in the statements of the rejection. Thus, the rejection of these claims is mooted and obviated by their cancellation.

In regards to claim 21, item 4 of the Office Action stated the following:

“Myers discloses integrating a sintered material containing amounts of iron and copper as required by the instant claims, as well as aluminum, to a steel backing plate. Myers uses this material as a friction material in a brake pad; it is thus a reasonable assumption that backing plates that are substantially cylindrical would fall within the purview of the Myers reference.

Myers does not state the function of the various components of this system as claimed, i.e. does not state that the iron causes an order-disorder transition, that the aluminum causes expansion, or that the copper is used as an element for generating a liquid phase. However, given that these components may be present in the same amounts in both the process disclosed by Myers and that as claimed, it is a reasonable assumption that the functions or resultant effects of these components would likewise be the same in both the prior art and the claimed invention.”

Although Myers teaches adding minerals such as Alumina, Aluminum Oxide, Chrome Oxide, Magnesium Oxide, Lead Oxide, Barium Sulfate, Quartz, Silicon Carbide, Clay, Mica, Wollastonite, Ceramic Fibers, Asbestos Fibers and other mineral fibers as inorganic materials, Myers fails to disclose, teach, or even suggest the addition of **metallic Al** as an essential element, as in the present invention (see *Myers* at column 4, lines 1-4) (*Alumina, as disclosed by Myers, is not metallic Al, but rather is a form of Aluminum Oxide, Al₂O₃*).

Accordingly, because Myers fails to disclose, teach, or suggest each and every limitation of claim 21, a *prima facie* case of obviousness has not been established, and withdrawal of this rejection is respectfully requested. See, e.g., *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); accord. MPEP 2143.03.

Claim Rejections- Alleged Double Patenting

In the Action, claims 21, 26, 27, and 28 were rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-13 of U.S. Patent No. 6,428,744. This rejection is respectfully traversed.

As noted above, claims 26-28 are now canceled without prejudice or disclaimer, and without necessarily agreeing with or acquiescing in the statements of the rejection. Thus, the rejection of these claims is mooted and obviated by their cancellation.

In regards to claim 21 of the present Application, claims 1-13 of U.S. Patent No. 6,428,744 are directed to a joining method of a copper-base contact material containing 1 to 30 wt% PB and at least 0.5 to 10 wt% of one or more elements selected from Ti and Mg. More specifically, it discloses Cu-6Ti-5Pb-4Sn-3NiAl alloy (see Table 1, Alloy No. 7 of U.S. Patent No. 6,428,744). However, claims 1-13 of U.S. Patent No. 6,428,744 fail to disclose, teach, or even suggest the joining method of a contact material as recited in claim 21 of the present Application, in which the material contains at least one element selected from the group consisting of Al, Si, Co, and Ni and having 10% by volume or more a Fe base alloy phase which causes an order-disorder transition.

Accordingly, because claims 1-13 of U.S. Patent No. 6,428,744 fail to disclose, teach, or suggest each and every limitation of claim 21, a *prima facie* case of obviousness has not been established, and withdrawal of this rejection is respectfully requested. *See, e.g., In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *accord.* MPEP 2143.03.

CONCLUSION

For at least the foregoing reasons, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the examiner is respectfully requested to pass this application to issue. If the examiner has any comments or suggestions that could place this application in even better form, the examiner is invited to telephone the undersigned attorney at the below-listed number.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. KOM-140/INO/DIV from which the undersigned is authorized to draw.

Dated: December 28, 2006

Respectfully submitted,

By 

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